REMARKS

The Examiner has rejected claim 29 under 35 U.S.C. 102(b) over WO 99/14408. It is respectfully submitted that the rejection is not well taken.

Applicant would like to notify the Examiner that reference WO 99/14408 is commonly owned and related to the present application, each of WO 99/14408 and the present application sharing the same sole inventor, Charles Edward Bowers. The Examiner is also notified that the United States patent equivalent to WO 99/14408 is issued U.S. patent 6,682,618.

The presently claimed invention relates to a method for the manufacture of Saxony carpet. More particularly, the invention pertains to a method for making Saxony carpets using untwisted wrapped singles yarns, which is a longstanding need in the art. As discussed on page 4, lines 1-3 of the present application, the current invention is an improvement over the inventions disclosed in WO 99/14408 and patent application serial number 08/933,822, now U.S. patent 6,682,618, commonly owned.

The claimed invention differs from the applied reference because WO 99/14408 does not teach untwisted wrapped singles yarns, particularly comprising a base synthetic fiber wrapper yarn containing heat activated binder material. These features result in the formation of yarns having greater texture retention, tip definition, bulk and wear resistance than those taught by WO 99/14408. Further, the presently claimed invention allows for the elimination of the slow and expensive steps of twisting, plying and re-twisting of a singles yarn previously necessary for the formation of Saxony carpets.

It is respectfully submitted that WO 99/14408 only teaches a generic wrapped yarn where a heat activated binder material is incorporated in a wrapper yarn. More particularly, their yarn is then twist set under high temperatures in standard twisting processes.

Indeed, WO 99/14408 pertains entirely to a fiber that retains good properties after being subjected to common high temperature twist setting procedures. The Examiner is directed particularly to page 4, lines 11-21 of WO 99/14408 which discusses the utility of the reference for such twist setting procedures, whereby the use of a heat-activated binder having a lower melting point compared to a base fiber offers an improved response to twist setting, resulting in improved properties. The Examiner is further directed to page 6, lines 1-20, which describes the twist setting conditions, e.g. the Suessen twist setting process, that WO 99/14408 employs. In contrast, the claimed invention is directed solely to the formation of Saxony carpet using untwisted wrapped singles yarns that are not twist set. Therefore, the carpet of the claimed invention and a carpet formed via the WO 99/14408 reference have significant structural differences.

The Examiner has interpreted the "incorporating" step of claim 29 to read on forming a plied twisted yarn from a pair of wrapped singles yarns, followed by tufting the plied twisted yarn to a carpet backing. It is respectfully submitted that the examiner is incorrect. For clarification purposes, claim 29 is being amended to clarify that steps d) and e) involve the processing of an untwisted yarn. It is respectfully asserted that the method of the claimed invention is neither taught nor suggested, particularly for the formation of Saxony carpets having tuft definition, tip retention, and hand and wear resistance equivalent to or better than carpets of equal pile weight made from multiple plied twist set yarns. For these reasons, it is respectfully submitted that the claims are not anticipated by the applied reference, and the rejection should be withdrawn.

The Examiner has rejected claim 29 under 35 U.S.C. 103(a) over WO 99/14408 in view of either U.S. patent 4,147,508 to Perrig or JP 2300340 and optionally further in view of U.S. patent 4,668,552 to Scott. It is respectfully submitted that the rejection is not well taken. The arguments with regard to WO 99/14408 are repeated from above and apply equally herein.

The Examiner has further applied Perrig or JP 2300340 and optionally Scott. Perrig teaches a process for the simultaneous dyeing and bonding of polyamide fibers. The invention described by Perrig is very different than the presently claimed invention. Particularly, Perrig presents a process for adding color to a fiber band followed by bonding the fiber band into an untwisted dyed yarn or band. It is respectfully submitted that a combination of Perrig with WO 99/14408 would still result in a carpet wherein the fibers have been twist set as described in the WO 99/14408 reference. There is simply no teaching or suggestion in Perrig that their polyamide fibers are directly formed into carpeting after their fiber band is bonded to an untwisted yarn or band. The teachings of Perrig are directed simply to the coloration of fiber bands and subsequent bonding to another or band. Moreover, Perrig does not describe singles yarns, but multi-ply yarns.

It is submitted that one skilled in the art would not be motivated to arrive at the presently claimed invention upon reading Perrig in combination with WO 99/14408. In establishing a *prima facia* case of obviousness under 35 U.S.C. 103, it is incumbent upon the Examiner to provide a reason why one having ordinary skill in the art would have been led to combine references to arrive at the claimed invention. The requisite motivation must stem from some teaching, suggestion or interest in the prior art as a whole or from knowledge generally available to one having ordinary skill in the art. See *Uniroyal, Inc. v. Rudkin Riley, Corp.*, 837 F. 2d 1044, 5 USPQ 2d 1434 (Fed. Cir. 1988); *Ashland Oil, Inc. v. Delta Resin And Refractories, Inc.*, 776 F. 2d 281, 227 USPQ 657 (Fed. Cir. 1985).

Where claimed subject matter has been rejected as obvious in view of prior art references, a proper analysis under 35 U.S.C. 103 requires consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or article or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out the claimed invention those of ordinary skill would have a reasonable expectation of success. See *In Re Dow Chemical Company* 837 Fed. 2d 469, 473, 5 USPQ 2d 1529, 1531 (Fed. Cir.

1988). Both the suggestions and the reasonable expectation of success must be found in the prior art, not in applicant's disclosure.

Applicants respectfully assert that such a suggestion and reasonable expectation of success cannot be found in the cited references. Neither WO 99/14408 nor Perrig, taken singularly or in combination, teach or suggest the claimed subject matter. Specifically, the applied references neither anticipate nor suggest the formation of a Saxony carpet with an untwisted, heat-treated, wrapped singles yarn.

Similar to Perrig, JP 2300340 fails to overcome the deficiencies between WO 99/14408 and the claimed invention. JP 2300340 describes a multi-ply yarn including a sliver 1 and a filament 2 that are aligned in parallel to form a conjugate yarn, and a filament yarn 3 that is wound around the conjugate yarn. JP 2300340 does not teach or suggest the heat setting of their multiple individual fibers into a singles yarn. Accordingly, JP 2300340 is very different than the claimed invention.

It is asserted that one of ordinary skill in the art would not look to combine JP2300340 with WO 99/14408 to arrive at the present invention. It is respectfully submitted that the Examiner is reconstructing the art in light of Applicant's disclosure. An invention cannot be deemed unpatentable merely because, in a hindsight attempt to reconstruct the invention, one can find elements of it in the art; it must be shown that the invention as a whole was obvious at the time the invention was made without knowledge of the claimed invention. When selective combination of prior art references is needed to make an invention seem obvious, there must be something in the art to suggest that particular combination other than hindsight gleaned from the invention itself, something to suggest the desirability of the combination. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 5 U.S.P.Q.2d 1434, 1438 (CAFC 1988). This teaching or suggestion is absent in the selected combination of references.

The point in time that is critical for an obviousness determination is at the time the invention. "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Obviousness cannot be established by hindsight combination to produce the claimed invention. *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). It is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination.

The Examiner states that it would have been obvious in the art to directly incorporate a resultant heat treated yarn into a carpet primary backing because Perrig and JP 2300340 show the incorporation of either a heat treated or twist free yarn into a carpet primary backing as loops. It is respectfully submitted that the Examiner has applied an improper standard of patentability. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Likewise, the belief that one skilled in the art could form the claimed multilayered film does not suggest that one should form such a film to obtain the disclosed benefits. Moreover, as the Board of Patent Appeals and Interferences stated in *Ex parte Levengood*, a statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). Accordingly, it is respectfully submitted that Perrig and JP 2300340 each fail to overcome the deficiencies between WO 99/14408 and the claimed invention.

The Examiner also applies U.S. patent 4,668,552 to Scott optionally further in view of Perrig or JP 2300340. It is respectfully submitted that Scott fails to overcome the deficiencies between the claimed invention and WO 99/14408 in combination with either Perrig or JP 2300340. The Examiner has applied Scott as further evidence that it is known in the art to directly use a heat setting wrap yarn in forming a cut pile fabric. However, there simply is no teaching or suggestion in the applied art to combine the applied references as the Examiner has done to arrive at the claimed invention. It is further submitted that the combined teachings of the prior art must render the claimed invention as a whole obvious at the time the invention was made, not just its individual elements or steps. Moreover, it is inappropriate to use hindsight guided by the Applicant's disclosure. One must place one's self at the time the invention was made and use only the prior art that existed then in an obviousness determination. The applied references simply do not offer such a teaching or suggestion to arrive at the claimed invention, when taken as a whole, without having hindsight knowledge or the presently claimed invention.

As set forth hereinabove, Applicant respectfully asserts that the references do not teach or suggest the combination as set forth in the claims, as is evident from the plurality of differences between applicant's invention and the cited art. As such, it is respectfully submitted that none of the applied references, either alone or in combination, teach or suggest the claimed invention. For these reasons, it is respectfully submitted that the rejection is improper and should be withdrawn. Such action is requested.

The Examiner has rejected claim 29 under 35 U.S.C. 103(a) over WO 99/14408 in view of JP 2300340. It is respectfully submitted that the rejection is not well taken. The arguments regarding both WO 99/14408 and JP 2300340 are repeated from above herein. The Examiner asserts that it would have been obvious to replace a wrapping filament yarn of JP '340 with a wrapper yarn comprising a blend of heat activated binder fibers and base synthetic fibers, because WO '408 teaches the desirability of forming a wrapper yarn comprising a heat activated binder fiber with a base fiber to make a singles yarn.

However, there is simply nothing in the combination of the WO 99/14408 and JP 2300340 references that would teach or suggest the claimed invention as a whole to one skilled in the art, particularly with a reasonable expectation of success. Accordingly, it is respectfully submitted that the rejection is incorrect and should be withdrawn.

The undersigned respectfully requests re-examination of this application and believes it is now in condition for allowance. Such action is requested. If the examiner believes there is any matter which prevents allowance of the present application, it is requested that the undersigned be contacted to arrange for an interview which may expedite prosecution.

Respectfully submitted,

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I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office (FAX No. 703-872-9306) on May 5, 2005.

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